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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,219	04/13/2004	Shumpei Kawasaki	101-9409J	6297

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,219

Applicant(s)

KAWASAKI ET AL.

Examiner

Nabil M. El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-22 are pending in this application. Claims 1-16 are cancelled. Claims 17-22 are new and presented for examination.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,748,507 hereafter "507". Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and 507 disclose components of a data processor with central processing unit, a clock generator, control unit, mode register, a plurality of operating modes, external interrupt signal, and a controller to control data transfer to outside the data processor.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of

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paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchiyama et al. (USPN 5,574,876), hereafter "Uchiyama".

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. As to claim 17, Uchiyama discloses the invention as claimed including a data processor comprising a central processing unit executing a plurality of instructions (MPU 101, Fig. 2), a clock pulse generator generating a plurality of clock signals (CG 103, and signals 150, 151, and 152, Fig. 1), a mode register accessed by the central processing unit (CMR 505, Fig. 5A; and col. 5, lines 58-59), wherein the data processor operates in accordance with a plurality of operation modes (abstract), wherein the central processing unit executes instructions and receives a clock signal from the clock pulse generator in a first mode of operation (col. 4, lines 56-61; and 150 clock signal, Fig. 1), wherein the central processing unit halts executing the instructions and the clock pulse generator generates clock signals in another mode of operation (col. 4, lines 28-40; and col. 5, lines 58-64), and wherein the central processing unit and the clock pulse generator halt operation in one mode of operation (col. 4, lines 28-40; col. 5, lines 58-64; and col. 9, lines 14-21).

7. As to claim 18, Uchiyama discloses a control terminal receiving a level signal for the data processor to change operation (104, Fig. 7).

8. As to claim 19, Uchiyama discloses an external interrupt receive terminal which receives an interrupt request from outside the data processor in order to change the operation mode of the data processor (col. 5, lines 60-64).

9. As to claim 20, Uchiyama discloses a reset terminal, which receives a signal from outside the data processor in order to change the operation mode of the data processor (col. 5, lines 60-64).

10. As to claim 21, Uchiyama discloses halting providing a generated clock signal to the central processing unit in one mode of operation (inherent in col. 4, lines 28-40).

11. As to claim 22, Uchiyama discloses a data transfer controller that controls data transfer between the data processor and outside of the data processor (MS CONTROL UNIT 704 of Fig. 7 as part of MC CORE 104, Fig. 12, controlling data transfer between MPU CORE 101 and outside MS 102), and the clock pulse generator provides a clock signal to the central processing unit and halts providing clock signal to the data transfer controller in one mode of operation (col. 9, lines 16-17) .

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Bilbrey et al. (USPN 5,227,863) ; Takasugi (USPN 5,430,688); Olsen et al. (US 4,519,028) ; Schlotterer et al. (US 3,827,029) ; Miwa et al. (US 5,228,139) ; Thomas (US 5,386,563) ; Miwa et al. (US 5,581,698); and West et al. (US 4,849,702).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 27, 2005



Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
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